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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/529,020

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Yan Gao

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8814

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EXAMINER

DOLLINGER, MICHAEL M

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

10/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,020	Applicant(s) GAO ET AL.	
	Examiner MICHAEL DOLLINGER	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 15-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claim 17 is objected to because of the following informalities: "(Ds)" in line 2 should be "(DS)". Appropriate correction is required.
2. Claim 17 is objected to because of the following informalities: "Claim15" in line 2 should have a space between "Claim" and "15", e.g. "Claim 15". Appropriate correction is required.
3. Claim 30 is objected to because of the following informalities:
"poly(phthalazinone) ether sulfone" in line 2 should be "poly(phthalazinone) ether sulfone ketone". Appropriate correction is required.
4. Claim 32 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 32 merely repeats the limitations of claim 19, from which claim 32 depends.

Claim Rejections - 35 USC § 103

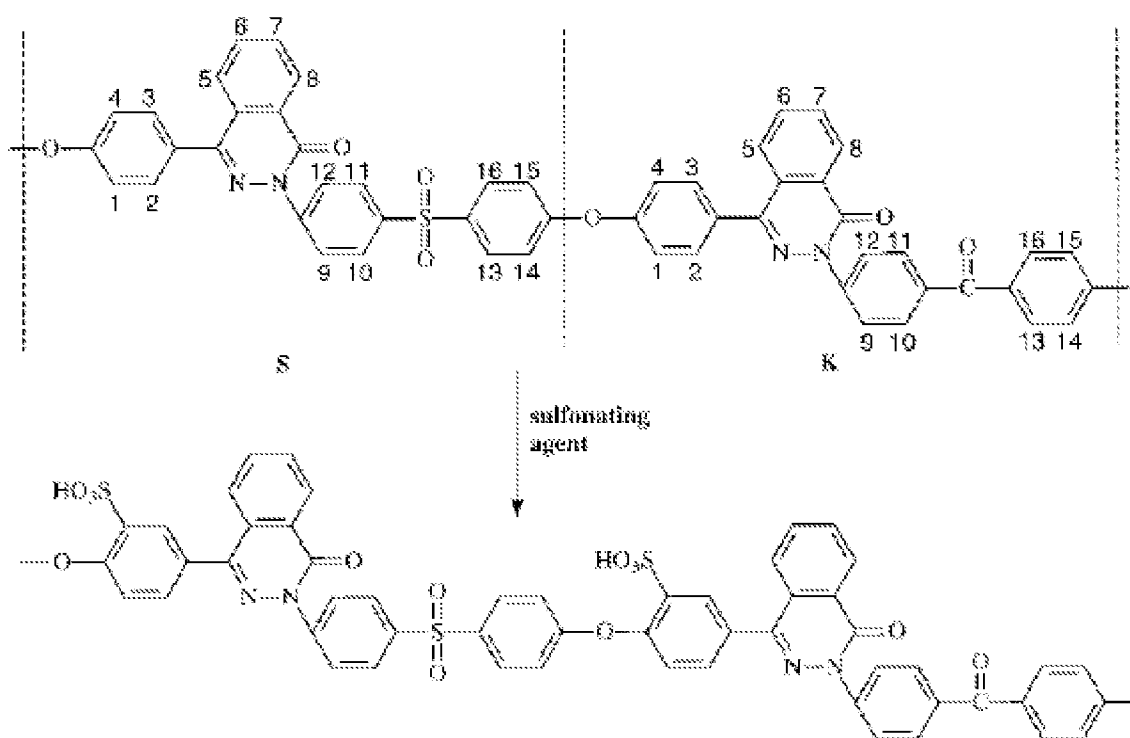
5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 15-32 are rejected under 35 U.S.C. 103(a) as being obvious over Dai et al (Synthesis and characterization of sulfonated poly(phthalazinone ether sulfone ketone) for ultrafiltration and nanofiltration membranes. Journal of Applied Polymer Science. Vol. 79 No. 9 pages 1685-1692).

7. Dai et al disclose sulfonated poly(phthalazinone ether sulfone ketone) copolymers (SPPESKs) formed by the following reaction:



[Scheme 1 page 1687].

The sulfonating agent may be 98% concentrated sulfuric acid or 20-25% fuming sulfuric acid [page 1686 left column paragraph 3]. The moderate sulfonated SPPESK (MSPPESK) has a DS of 35-150% [Table I page 1686] and one embodiment of MSPPESK has a DS of 79.3% [Table II page 1689]. The polymers may be cast into

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membranes [page 1690 left column paragraph 1]. Dai et al disclose that the DS is depends on the reaction time and the strength of the sulfonating agent, specifically DS increases with the solution concentration of SO_3 [page 1688 right column paragraph 2; Figure 3].

8. While the above disclosed polymer contains an additional sulfone phthalazinone structural unit, it still reads on the polymer of structural formula I in claim 15. There is no claim language or features of structural formula I that exclude other monomer units. Additionally, the above disclosed polymer reads on the sulfonated poly(phthalazinone) ether sulfone ketones of claim 30.

9. Fuming sulfuric acid is a mixture of H_2SO_4 and SO_3 and concentrated sulfuric acid is a mixture of H_2SO_4 and water. When fuming sulfuric acid and concentrated sulfuric acid are mixed, the SO_3 molecules react with the water molecules to produce H_2SO_4 . Fuming sulfuric acid is inherently a mixture of concentrated sulfuric acid fuming sulfuric acid and a supersaturated aqueous sulfuric acid solution. Henceforth, changing the solution concentration of SO_3 , as taught by Dai et al and discussed above, is varying the ratio of concentrated sulfuric acid to fuming sulfuric acid in the sulfonating agent as claimed in claims 22 and 23.

10. The SPPEK disclosed in Dai et al and shown above in Scheme 1 does not show a sulfonic acid group on the phenyl group attached to the ketone group, as claimed in claim 15. Dai et al teach, however, that the PPESK polymers are sulfonated in order to increase the hydrophilicity of the polymer for use in membranes for application in water treatment and gas treatment [page 1686 left column paragraph 1].

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Dai et al also teach that increasing DS decreases the contact angle with water (increases hydrophilicity) [page 1690 Table V]. Sulfonating the phenyl group attached to the ketone group would increase the DS and henceforth increase hydrophilicity of the SPPEESK. Conversely, increasing the DS will eventually sulfonate the phenyl group attached to the ketone group. It would have been obvious to one having ordinary skill in the art at the time the invention was made to sulfonate the phenyl group attached to the ketone group in the SPPEESK in Dai et al because Dai et al teach that it is within the skill of the art to increase the hydrophilicity of a SPPEESK by increasing the DS. One would have been motivated to increase the hydrophilicity in order to increase the utility of the SPPEESKs as membranes for applications in water treatment and gas treatment, as taught by Dai et al.

11. Regarding claims 20 and 21, Dai et al do not disclose a sulfonating agent as a mixture of 95-98% concentrated sulfuric acid and 27-33% fuming sulfuric acid with different acid ratios. However, Dai et al do disclose sulfonating agents of 98% concentrated sulfuric acid and 20-25% fuming sulfuric acid [page 1686 left column paragraph 3].

12. It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. See *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined 98% concentrated sulfuric acid

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and 20-25% fuming sulfuric acid in order to make a sulfonating agent for PPESK polymers.

13. While the disclosed 20-25% fuming sulfuric acid does not overlap with the claimed 27-33% fuming sulfuric acid, the ranges are close enough that one having ordinary skill in the art would expect them to have the same properties. *A prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have similar properties. See *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

14. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dai et al (Synthesis and characterization of sulfonated poly(phthalazinone ether sulfone ketone) for ultrafiltration and nanofiltration membranes. Journal of Applied Polymer Science. Vol. 79 No. 9 pages 1685-1692) in view of Helmer-Metzmann et al (US 6,214,488), and in further view of Hodgdon et al (US 3,528,858), and with further evidence provided by Larminie et al (Fuel Cell Systems Explained).

15. Dai et al do not disclose a membrane electrode assembly with a solid polymer electrolyte membrane between an anode and a cathode. Dai et al do teach, however, that the membrane formed from SPPEsk was stable up to 120°C and even up to 130°C [page 1691 left column paragraph 1]

16. Helmer-Metzmann et al teach that sulfonated poly(aryl ether ketones) may be used to produce a polymer electrolyte membrane [abstract] useful for hydrogen/oxygen

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fuel cells [column 1 lines 11-15]. The SPPEsk polymers of Dai et al are poly(aryl ether ketones) wherein one of the arylene groups is a phthalazinone.

17. Hodgdon et al teach that sulfonated polymer ion exchange membranes that are stable above ambient temperatures are ideally suited for use in fuel cells [column 1 lines 23-27]. Hodgdon et al also teach that it is well understood in the art that when membranes are mounted in a fuel cell that are used in combination with an anode and a cathode [column 7 lines 9-12].

18. Larminie et al show the basic structure of a cathode-electrolyte-anode construction of a fuel cell [page 3 Figure 1.2] wherein the electrolyte is between the anode and the cathode. Larminie et al simply provide evidence that the disclosure of a polymer electrolyte membrane fuel cell inherently has an anode, a cathode and an electrolyte membrane in between the cathode and anode.

19. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have produced a fuel cell with a SPPEsk polymer electrolyte membrane between an anode and a cathode because Dai et al teach that it is within the skill of the art to produce a SPPEsk polymer and Helmer-Metzmann et al teach that it is within the skill of the art to produce a fuel cell with a sulfonated poly(aryl ether ketone) membrane. One would have been motivated to do this because Dai et al teach that the SPPEsk polymer membranes are stable up to 130°C and Hodgdon et al teach that highly thermally stable electrolyte membranes are ideal for fuel cells. Absent any evidence to the contrary, there would have been a reasonable expectation of success in producing a fuel cell with a SPPEsk polymer electrolyte membrane.

International Search Report

20. The X category reference Polymer vol. 43, 2002, pages 5335-5339 cited in the International Search Report was not used in a 35 USC 102 rejection because the polymers of the reference do not contain a ketone group.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL DOLLINGER whose telephone number is (571)270-5464. The examiner can normally be reached on Monday - Thursday 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MICHAEL DOLLINGER
Examiner
Art Unit 1796

/mmd/

/Randy Gulakowski/
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